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10/083,250	02/27/2002	Geoffrey Stiff	52493.000251	2570

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EXAMINER

SWARTZ, JAMIE H

ART UNIT	PAPER NUMBER
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3694

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/083,250

Applicant(s)

STIFF ET AL.

Examiner

JAMIE H. SWARTZ

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 13 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-36 and 45-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-36 and 45-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is in response to the amendment filed on April 13, 2009. Claims 30-36 and 45-59 are pending. Claims 30, 55, 58, and 59 have been amended.

Response to Arguments

2. Applicant's arguments filed April 13, 2009 have been fully considered but they are not persuasive.
3. The applicant argues the 112 2nd rejection on pages 7-9 of the applicant response. The applicant appears to be claiming that in the specific instance of claim 30 the account goes negative. The examiner is not stating that accounts can never go negative. The examiner is merely pointing out that the claims are unclear. Traditionally accounts are set up to specifically be able to handle a negative balance. Further the claim is "storing a balance," within the context of the claim there is a left over value that is stored in an account. There is nothing left over to be stored in a specific account if the period retirement income payment amount is less than the guaranteed minimum periodic retirement income payment amount. The examiner can not locate in the specification that specifically states that when the account value goes negative. Does the applicant mean to claim that the difference is stored or even that an adjustment is stored?

4. The applicant argues on page 11 that the rejection of claims 58 and 59 are the same as the rejection of claim 30. The examiner agrees and upholds the rejection of claims 58 and 59.

5. The applicant argues starting on page 11 the Dellinger does not teach an equity module. The examiner respectfully disagrees. Because applicants can be their own lexicographers the prior art does not need to teach the specific phrase "equity module." The prior art merely needs to teach everything that the applicant is doing. As long as the prior art teaches the functionality of the invention the prior art is not required to teach the specific phrase "equity module." Dellinger teaches receiving an income generating payment and outputting a period retirement income payment. The applicant argues that the reference is not fairly interpreted. The examiner respectfully disagrees. Dellinger teaches an annuity based retirement program. Specifically an annuity that generates retirement income. Further an annuity is well known in the art to contain stocks, it is also specifically mentioned in the background of the prior art. Because stocks represent an ownership in a company, stocks are considered a type of equity. Thus using an example of an annuity made up of stocks which generates a retirement income as taught by Dellinger, Dellinger teaches an equity module.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 30-36 and 45-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Regarding claims 30, 55, 58, and 59, the phrase "the adjustment module storing a balance in an adjustment account if the periodic retirement income payment amount is less than the guaranteed minimum period retirement income payment" renders the claim indefinite. It is unclear to the examiner how a balance would be stored in the adjustment account. If the periodic retirement income payment is less than the guaranteed minimum payment wouldn't the "balance" be a negative value? Thus there would be no balance to store into the adjustment account. For example if a minimum periodic retirement income payment amount is \$100, but the periodic retirement income payment amount is \$95, how is the value a positive \$5 left as the balance? Are the guaranteed minimum periodic retirement income payment amount an amount that is being put into a module, and then the periodic retirement income payment amount the value that is being paid out to the user? If the guaranteed periodic retirement income payment amount is the amount paid out to the user it would not make sense for there to be any funds left over if that value is greater than the periodic retirement income payment amount. Because the minimum payment amount is still a minimum payment amount and in order for it to be the minimum payment amount the user must be paid the minimum.

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9. Claims 31-36, 45-54, and 56-67 are also rejected as being dependent on rejected claims.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 30-36 and 45-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Dellinger et al. (US 7089201 B1).

12. Regarding claim 30, Dellinger teaches a system for providing a user with a plurality of guaranteed minimum retirement income payments (see at least abstract, col. 4, lines 30-46, Fig 5). Dellinger teaches an equity module to receive an income generating payment and to output a periodic retirement income payment amount wherein the periodic retirement income payment amount is greater than, equal to, or less than a guaranteed minimum periodic retirement income payment amount if the income generating payments received are received according to a predetermined payment schedule (see at least col. 4, line 30-46, Fig. 5, col. 8, lines 35-50, col. 8, line

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66 – col. 9, line 5). Dellinger teaches an adjustment module for comparing the periodic retirement income payment amount and the guaranteed minimum periodic retirement income payment amount, and for outputting to the user at least the guaranteed minimum periodic retirement income payment amount, with the adjustment module storing a balance in an adjustment account if the periodic retirement income payment amount is less than the guaranteed minimum periodic retirement income payment amount (see at least col. 8, lines 35-50, col. 8, line 66 – col. 9, line 5).

13. Regarding claim 31, Dellinger teaches wherein the equity module comprises at least one of a variable annuity module, a fixed annuity module, a mutual funds module, a variable life module, a single premium immediate annuity (SPIA) module, and an immediate variable annuity module (see at least col. 4, line 30 – col. 6, line 12).

14. Regarding claim 32, Dellinger teaches wherein the periodic retirement income payment may be calculated at one of the following annually, biennially, semi-annually, quarterly, monthly, bi-monthly, semi-monthly, weekly, and bi-weekly (see at least col. 7, lines 20-35, col. 12, line 60 – col. 13, line 5).

15. Regarding claim 33, Dellinger teaches wherein the guaranteed minimum periodic retirement income payment amount may be calculated at one of the following annually, biennially, semi-annually, quarterly, monthly, bi-monthly, semi-monthly, weekly, and bi-weekly (see at least col. 12, line 60 – col. 13, line 5).

16. Regarding claim 34, Dellinger teaches wherein the adjustment account balance is recovered by the performance of a unitized investment trust or an index (see at least col. 10, lines 3-15, col. 13, line 50 – col. 14, line 2).

17. Regarding claim 35, Dellinger teaches wherein the guaranteed minimum periodic retirement income payment amount is predetermined by the user (see at least col. 10, line 40-48, abstract).

18. Regarding claim 36, Dellinger teaches wherein the guaranteed minimum periodic retirement income payment amount is predetermined by the total premium payments made by the user during an accumulation period (see at least col. 18, lines 27-36).

19. Regarding claim 45, Dellinger teaches wherein the output of the adjustment module to the user is based on the balance in the adjustment account (see at least col. 5, lines 16-36, col. 11, lines 49-57).

20. Regarding claim 46, Dellinger teaches wherein the output of the adjustment module to the user is equal to the periodic retirement income payment amount, if the adjustment account balance is zero and the periodic retirement income payment amount is greater than the guaranteed minimum periodic retirement income payment

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amount (see at least col. 15, line 64 – col. 16, line 23, col. 8, lines 49-59, col. 11, lines 16-35).

21. Regarding claim 47, Dellinger teaches wherein the income generating payment comprises a plurality of predetermined scheduled premium payments (see at least col. 4, line 30 – col. 6, line 12, col. 13, lines 50 – col. 14, line 2).

22. Regarding claim 48, Dellinger teaches wherein the income generating payment comprises a plurality of predetermined premium payments (see at least col. 4, line 30 – col. 61, line 12, col. 18, lines 13-60).

23. Regarding claim 49, Dellinger teaches wherein the income generating payment comprises a single premium payment (see at least col. 10, line 56 – col. 11, line 17).

24. Regarding claim 50, Dellinger teaches wherein the income generating payment comprises a plurality of premium payments (see at least col. 18, lines 15-67).

25. Regarding claim 51, Dellinger teaches wherein the guaranteed minimum periodic retirement income payment amount is determined by the amount and timing of the premium payments made by the user during the accumulation period (see at least col. 18, line 15-67, col. 4, line 30 – col. 6, line 12).

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26. Regarding claim 52, Dellinger teaches wherein the adjustment account balance is forgiven as a death benefit during the annulization period or at the expiration of the certain period, whichever occurs later (see at least abstract, col. 10, line 56 – col. 11, line 3, col. 11 lines 40 –49, col. 12, lines 10 –35, col. 14, lines 3 – 21).

27. Regarding claim 53, Dellinger teaches wherein an administrator retains a secured interest in future periodic retirement income payment amounts, if the adjustment account reflects a balance (see at least col. 4, line 55 – col. 5, line 16, col. 12, lines 43 –60, col. 14, lines 3-10, and lines 43 – 61).

28. Regarding claim 54, Dellinger teaches wherein the administrator is a financial services carrier (see at least abstract, claim 25).

29. Regarding claim 55, Dellinger teaches a method for providing a user with a plurality of guaranteed minimum retirement income payments, comprising: receiving an income generating payment at an equity module (see at least abstract, col. 4, lines 30-46, Fig 5) Dellinger teaches outputting a periodic retirement income payment amount, using the equity module, wherein the periodic retirement income payment amount is greater than, equal to, or less than a guaranteed minimum periodic retirement income payment amount if the income generating payments received are received according to a predetermined payment schedule, and wherein the guaranteed minimum periodic retirement income payment amount is defined by the user (see at least col. 4, line 30-

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46, Fig. 5, col. 8, lines 35-50, col. 8, line 66 – col. 9, line 5, col. 18, lines 15-67).

Dellinger teaches comparing the periodic retirement income payment amount and the guaranteed minimum periodic retirement income payment amount using an adjustment module (see at least col. 15, lines 35-63, col. 16, lines 37 – 57, col. 4, line 55 – col. 6, line 12). Dellinger teaches outputting, using the adjustment module, to the user at least the guaranteed minimum periodic retirement income payment amount, the adjustment module storing a balance in an adjustment account if the periodic retirement income payment amount is less than the guaranteed minimum periodic retirement income payment amount (see at least col. 4, line 30-46, Fig. 5, col. 8, lines 35-50, col. 8, line 66 – col. 9, line 5, col. 18, lines 15-67, col. 5, lines 16-36, col. 11, lines 49 –57).

30. Regarding claim 56, Dellinger teaches forgiving the adjustment account balance as a death benefit during the annuitization period or at the expiration of the certain period, whichever occurs later (see at least abstract, col. 10, line 56 – col. 11, line 3, col. 11 lines 40 –49, col. 12, lines 10 –35, col. 14, lines 3 – 21).

31. Regarding claim 57, Dellinger teaches wherein the equity module comprises and equity indexed annuities or an equity indexed immediate annuities (see at least col. 10, lines 3-15, col. 13, line 50 – col. 14, line 2).

32. Regarding claim 58, Dellinger teaches a system for providing a user with a plurality of guaranteed minimum retirement income payments (see at least abstract, col.

4, lines 30-46, Fig 5). Dellinger teaches an equity module to receive an income generating payment and to output a periodic retirement income payment amount wherein the periodic retirement income payment amount is greater than, equal to, or less than a guaranteed minimum periodic retirement income payment amount if the income generating payments received are received according to a predetermined payment schedule (see at least col. 4, line 30-46, Fig. 5, col. 8, lines 35-50, col. 8, line 66 – col. 9, line 5). Dellinger teaches comparing the periodic retirement income payment amount and the guaranteed minimum periodic retirement income payment amount, determining if the periodic retirement income payment amount is greater than, equal to, or less than a guaranteed minimum periodic retirement income payment amount, and outputting to the user at least the guaranteed minimum periodic retirement income payment amount, with the adjustment module storing a balance in an adjustment account when the periodic retirement income payment amount is less than the guaranteed minimum periodic retirement income payment amount (see at least col. 8, lines 35-50, col. 8, line 66 – col. 9, line 5).

33. Regarding claim 59, Dellinger teaches a method for providing a user with a plurality of guaranteed minimum retirement income payments, comprising: receiving an income generating payment at an equity module (see at least abstract, col. 4, lines 30-46, Fig 5) Dellinger teaches outputting a periodic retirement income payment amount, using the equity module, wherein the periodic retirement income payment amount is greater than, equal to, or less than a guaranteed minimum periodic retirement income

payment amount if the income generating payments received are received according to a predetermined payment schedule, and wherein the guaranteed minimum periodic retirement income payment amount is defined by the user (see at least col. 4, line 30-46, Fig. 5, col. 8, lines 35-50, col. 8, line 66 – col. 9, line 5, col. 18, lines 15-67).

Dellinger teaches comparing the periodic retirement income payment amount and the guaranteed minimum periodic retirement income payment amount using an adjustment module (see at least col. 15, lines 35-63, col. 16, lines 37 – 57, col. 4, line 55 – col. 6, line 12). Dellinger teaches determining if the periodic retirement income payment amount is greater than, equal to, or less than a guaranteed minimum periodic retirement income payment amount outputting, using the adjustment module, to the user at least the guaranteed minimum periodic retirement income payment amount, the adjustment module storing a balance in an adjustment account when the periodic retirement income payment amount is less than the guaranteed minimum periodic retirement income payment amount (see at least col. 4, line 30-46, Fig. 5, col. 8, lines 35-50, col. 8, line 66 – col. 9, line 5, col. 18, lines 15-67, col. 5, lines 16-36, col. 11, lines 49 –57).

Conclusion

34. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMIE H. SWARTZ whose telephone number is (571)272-7363. The examiner can normally be reached on 8:00am-4:30pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/J. H. S./
Examiner, Art Unit 3694

/Kirsten S Apple/
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